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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,680	10/09/2001	Jerome James Workman JR.	KCC-16,805	5767

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EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/973,680	WORKMAN ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/14/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election with traverse of Group I in the reply filed on 11/1/2004 is acknowledged. The traversal is on the ground(s) that groups I and II should be grouped together, as PTFE is a polyolefin. This is not found persuasive because Group I specific enumerates the polyolefins included, which are polyethylene and polypropylene. PTFE is not one of these 2. Accordingly, claims 13-35 are withdrawn from consideration.

The requirement is still deemed proper and is therefore made FINAL.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no basis for an electrostatic adhesive in the specification, as applicant has discussed electrostatic adhesion, not adhesive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites that the article is free of a list of enumerated compounds, including acrylates. Then claim 5 recites that the adhesive includes a series of acrylates. The adhesive is recited as being part of the article. Therefore, this is

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contradictory. It appears that applicant means that the substrate is free of the compounds.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Dow Jr. et al 5120325. Dow Jr. et al shows a bandage having a polyethylene of polypropylene backing material with a skin adhering adhesive attached thereto. The reference does not specify the weight average molecular weight. However, the examiner notes that applicant has not stated that the specific molecular weight solves a stated problem or is for a particular purpose. As such, it the exact molecular weight would have been a mere matter of design choice for one skilled in the art. The examiner notes that Dow Jr. is not for the same purpose as applicant's invention. However, the only difference is intended use and the device is capable of measuring drug transfer. With respect to claims 3 and 4, the bandage of Dow Jr. is textured to resemble human skin. It is the examiner's position that as such, it would meet the criteria of claim 3. With respect to claims 5-7, it is the examiner's position that the adhesives listed in column 2, lines 45-62 include the enumerated adhesives in the claims. As such, the adhesive would have the recited properties. With respect to

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claims 10-12, the examiner takes official notice that it is known to provide packaging materials with an adhesive bandage and that adhesive bandages come in the sizes and shapes claimed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow jr. et al in view of Macphee et al 6762336. Macphee et al teaches the equivalence of adhesive and electrostatic adhesion (see column 4, lines 44-52). Hence, it would have been obvious to modify Dow jr. to use electrostatic adhesive, as it is merely the substitution of one known equivalent adhesion for another.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow jr. et al in view of Cartmell 5160328. Dow jr. et al is silent as to the thickness of the backing layer. Cartmell teaches a bandage like that of Dow jr. where the backing layer has a thickness of 20-100 microns, which overlaps the claimed range. Hence, it would have been obvious to modify Dow Jr. to use the thickness recited in Cartmell, as it is merely the selection of a known bandage size in the art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lock 4625720 shows a bandage with a polyoxyethylene diol material having a weight average molecular weight of 3000 (3 kg.mole).

Phillips 5396901 show transdermal dosimeters.

Aronowtiz et al 6503198 shows another transdermal sampling device.

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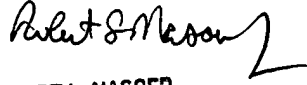
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
January 10, 2005


ROBERT L. NASSER
PRIMARY EXAMINER